

REMARKS/ARGUMENTS

Claims 1-14 are pending in the present application. In the Office Action mailed October 17, 2005, the Examiner rejected claims 1-14 under 35 U.S.C. § 112. The Examiner also rejected claims 1-14 under 35 U.S.C. § 102.

By this paper, Applicants respond to the above-recited rejections and add new claims 15-20. In light of the above-recited amendments and the following remarks, reconsideration and allowance of the pending claims is respectfully requested.

A. Claims 1-14 Rejected Under 35 U.S.C. § 112

The Examiner rejected claims 1-14 under 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed.

The M.P.E.P. states that “[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” M.P.E.P. § 2163 (citing Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991)). To establish an enablement rejection, “the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application.” In re Wright, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

Applicants respectfully submit that the above claims fully comply with 35 U.S.C. § 112, first paragraph. Independent claims 1 and 8 each recite “the gateway comprises device information about the embedded device.” In the Amendment and Response to Office Action filed August 2, 2005, Applicants amended claims 1 and 8 to recite this rejected element. Applicants indicated that support for this amendment may be found throughout the specification and, by way of an example, cited to a portion of the specification on page 9, lines 10-15.

In the Office Action, the Examiner stated that this element “was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art at the time the applicant was filed.” Office Action, page 2. The Examiner further argued that “[t]he device information 42 is inside the embedded devices 26 as Fig. 6 that is not comprised by the gateway 30b.” Id. at page 3. However, Applicants respectfully submit that, as stated in the prior response, there is further support for this amendment in other areas of the specification. For example, the specification recites,

The gateway 30b computer provides access to the services provided at the embedded computer 42 and at the embedded device 26. In the present embodiments, a portion of the device information 52, the interfaces supported information, is retrieved from the embedded device 26 and stored in services information 64 created at the gateway 30b computer and/or at the service provider 22 that substantially corresponds to the services of the embedded device 26. The list of services at the gateway 30b computer is referred to in Figure 8 as services information 64. The services information 64 indicates what services are available at the embedded device 26 and what data types, if any, are used with individual services. This facilitates access via the gateway 30b computer to the embedded device 26.

Specification, page 15, lines 22-30. Though the device information 42 may be stored inside the embedded devices 26, the device information 42 may also be “stored in services information 64 created at the gateway 30b computer.” See also Applicant’s Figure 8. Applicants submit that at least this portion of the specification contains a description sufficient to enable one skilled in the art to make and use the claimed invention. Therefore, Applicants respectfully request withdrawal of this rejection.

In addition, in regard to Office Actions that reject a claim under 35 U.S.C. § 112, first paragraph, the M.P.E.P. states that “where Office personnel establish a prima facie case of lack of written description for a claim, a thorough review of the prior art and examination on the merits for compliance with the other statutory requirements, including those of 35 U.S.C. 101, 102, 103, and 112, is to be conducted prior to completing an Office action which includes a rejection for lack of

written description.” M.P.E.P. § 2163. Applicants submit that the Examiner has not made the requisite “thorough review of the prior art and examination on the merits.”

In the Office Action, the Examiner responded to Applicants’ amendment and arguments by asserting that “the gateway does not comprise device information of the embedded device as the limitation of the claim.” Office Action, page 5. The Examiner has merely reiterated his rejection under 35 U.S.C. § 112, first paragraph, rather than making “a thorough review of the prior art and examination on the merits” with respect to this rejection under 35 U.S.C. § 102(e).

Applicants did add this limitation to the claims, and it is supported by the specification. However, the Examiner did not address this properly supported limitation in the Office Action. As such, Applicants respectfully request removal of the finality of this Office Action and request the Examiner perform the “thorough review of the prior art and examination on the merits” and respond to Applicants’ previous amendment and arguments as required by the M.P.E.P.

B. Claims 1-14 Rejected Under 35 U.S.C. § 102(e)

The Examiner rejected claims 1-14 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,295,293 to Tönnby et al. (hereinafter, “Tönnby”). This rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ... claim.” Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, “the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Applicants respectfully submit that the claims at issue are patentably distinct from Tönnby. Tönnby does not disclose all of the elements in these claims.

Despite the lack of a thorough examination of the previous Amendment and Response, Applicants respectfully submit that Tönnby does not disclose each and every element as set forth in claims 1 and 8. For example, Tönnby does not disclose a “gateway compris[ing] device information about the embedded device,” as recited in these claims.

In the Office Action, the Examiner asserted that Tönnby discloses “a gateway for electronic communications with the embedded device” and cited to block 24 in Figure 6. Office Action, page 4. Block 24 in Figure 6 is an “IP access node 24.” The Examiner has not cited, nor can Applicants find any portion of Tönnby that discloses a “gateway compris[ing] device information about the embedded device,” as recited in claims 1 and 8.

Rather, Tönnby discloses,

The NT has also a subscriber line interface 31. The IP access node [24] comprises an IP access server 32, the IP router 8 and the telephony server 9. The access line interface 27 belongs to the IP access server. The IP access server comprises a set of individual xDSL modems. The IP access server has also a telephony server interface 33. Over this interface IP packages containing telephony information are routed to and from the telephony server. Units 32, 9, 8 and 28 communicate with each other using IP packets belonging to an access network internal address space.

Tönnby, Col. 5, lines 10-19. Though this section does disclose telephony information that is “routed to and from the telephony server,” Applicants submit that telephony information is not “device information about the embedded device,” as recited in claims 1 and 8. Rather, Tönnby discloses that telephony information is “speech and control signals.” *Id.* at col. 8, lines 51-52. Therefore, Tönnby does not disclose each and every element of the claims. Consequently, Tönnby does not anticipate claims 1 and 8.

In view of the foregoing, Applicants respectfully submit that independent claims 1 and 8 are patentably distinct from Tönnby. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

Claims 2-7 and 15-17 depend either directly or indirectly from claim 1. Claims 9-14 and 18-20 depend either directly or indirectly from claim 8. Accordingly, Applicants respectfully request that the rejection of claims 2-7, 9-14, and 15-20 be withdrawn for at least the same reasons as those presented above in connection with claims 1 and 8.

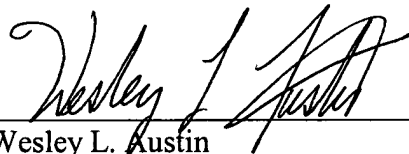
Finally, with respect to new claims 15-20, claims 15 and 18 include the limitation of “the device information comprises capabilities of at least one embedded device;” claims 16 and 19 include the limitation of “the device information comprises interfaces supported by at least one embedded device;” and claims 17 and 20 include the limitation of “the device information comprises data available on at least one embedded device.” Support for these limitations is found on page 9, lines 10-11 of Applicants’ specification. Applicants can find no disclosure of these claim elements anywhere in Tönnby’s disclosure. Accordingly, as these claim limitations are not disclosed by the prior art, these claims are immediately allowable. Favorable consideration and allowance of these claims is respectfully requested.

Appl. No. 09/911,152
Amdt. dated January 17, 2006
Reply to Office Action of October 17, 2005

C. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin", is written over a horizontal line.

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